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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,852	04/05/2004	Jefferson Grey Harcourt	119352	1806

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EXAMINER

LE, MARK T

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/816,852

Applicant(s)

HARCOURT, JEFFERSON GREY

Examiner

Mark T. Le

Art Unit

3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) 49-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-48 and 52-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/17/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-48 and 52-58, drawn to a retractable cable assembly, classified in class 191.
  - II. Claims 49-51, drawn to a method of making a flexible circuit board element, classified in class 174.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another different process, i.e. a process without the step of cutting a sheet of flexible circuit board.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. Joel Armstrong on April 1, 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-48 and 52-58. Affirmation of this election must be made by applicant in replying to this Office action. Claims 49-51 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the mechanism for manually turning recited in claim 20; the motor mechanism recited in claim 21; the motor activation circuitry recited in claims 22 and 56; the sensor recited in claim 27; and the control recited in claims 57-58, must be shown or the features must canceled from the claims. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-9, 11-17, 24-25, 28-31, 34-43, 45-48 and 52-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Wagner (US 5,590,749).

Wagner discloses a retractable cable assembly connected to an electronic device, and having all the features recited in the instant claims, including retractable cable 20 and flexible circuit board element 46.

Regarding claims 5-6, consider land portion 58 provided with connection circuitry 18 at one end of the land portion.

Regarding the instant claimed two or more retractable cables, recited in claim 35, consider the plurality of cables 198, shown in Figure 24 of Wagner.

Regarding the methods of forming the flexible circuit board element, recited in claims 37 and 39, note that such claimed methods of forming recited in an apparatus claim is not considered to be patentably significant because such methods do not present a structural distinction to define the instant claimed structure over the prior art structure.

Regarding instant claimed strip including a land portion, as recited in instant claims 38 and 48, consider land portion 58, shown in Figs. 3, 4 and 6 of Wagner, that extends from the end of strip 46 to an end of the land portion upon which electronic component 23,28 is mounted. It should also be noted that at least the middle part of land portion 58 of Wagner is angled to the winding axis of strip 46.

Regarding the instant claimed central land portion, recited in instant claim 39, consider the end of land portion 58 that is opposite to the other end that is connected to electronic component 23,28.

8. Claims 1, 10, 17-19, 20-23, 26-27, 32-33, 37, 43-44 and 56-58 are rejected under 35 U.S.C. 102(b) as being anticipated by Burke (Wo 00/31847).

Burke discloses a retractable cable assembly connected to an electronic device, and having all the features recited in the instant claims, including retractable cable 10 and flexible circuit board element 24.

Regarding the instant claimed cable having a flat configuration, as recited in instant claim 10, consider page 13, lines 15-18 of Burke.

Regarding claims 17-19, consider Figure 3 of Burke.

Regarding claims 20-21, consider page 9, lines 18-19 of Burke.

Regarding the instant claimed motor activation circuitry or a device with a circuitry to produce a signal for activating the motor, as recited in instant claims 22-23, and 56-58, note that in the alternative embodiment suggested by Burke that includes a motor, such motor inherently requires a form of motor activation circuitries, devices, or controls to activate the motor or deactivate the motor, as broadly required by the instant claims.

Regarding the instant claimed latch mechanism, recited in claim 26, consider latch mechanism 28,29 of Burke.

Regarding the instant claimed sensor for indicating that the cable is extended and/or retracted, as recited instant claim 27, note that the actual appearance of the

length of cord 10 of Burke positioned outside the assembly provides an indication as to whether the cord is extended or retracted.

Regarding the method of forming the flexible circuit board element, recited in claim 37, note that such claimed method of forming in an apparatus claim is not considered to be patentably significant because such method does not present a structural distinction to define the instant claimed structure over the prior art structure.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claim 48 is rejected under 35 U.S.C. 102(e) as being anticipated by Liao (US 6,390,261).

Liao discloses a structure having all the features recited in the instant claims, including a flexible flat cord element having coiled portion 13 coiled about an axis inclined to the plane of land portion 51, and electronic components 52-57 mounted on the land portion. Note that the flexible flat cord element Liao is readable as a flexible circuit board element, as broadly claimed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Le whose telephone number is 571-272-6682. The examiner can normally be reached on Mon-Fri (8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel Morano can be reached on 571-272-6684. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mark T. Le  
Primary Examiner  
Art Unit 3617

mle  
4/3/05